Pellegrino, Rachel

From: Hickey, Toni
Sent: Monday, February 07, 2011 1:41 PM
To: Pellegrino, Rachel
Subject: FW: Small Business Study

Follow Up Flag: Follow up
Flag Status: Flagged

From: TMFeedback
Sent: Monday, February 07, 2011 1:20 PM
To: Brown, Brian (TM); Hickey, Toni
Subject: FW: Small Business Study

From: Bressler, Barbara [(b)(6)]
Sent: Monday, February 07, 2011 11:39 AM
To: TMFeedback
Subject: Small Business Study

I write to report an instance of a threat to file an opposition to our client's trademark application by another company that was at that time, and apparently still is, filing oppositions or extensions of time to file an opposition against my client and any other party who attempted to register a mark containing a fairly common term. I believe the TM owner did so in order to attempt to make what was then a very weak mark into a strong mark. My client had filed an application for a word mark to be used in connection with "providing information to women in the field of self-improvement." At the time, the other company had a similar registered mark for "T-shirts and Tops" and another similar registered mark for a host of other apparel items, almost none of which could we find for sale by the TM Owner. Since that time, that mark has been amended to delete a significant number of items for which the owner originally claimed to be selling under the mark. The potential Opposer claimed that because my client had articles on her website about women's fashion, that there was a likelihood of confusion. My client sold no items on her website. We attempted to try to settle with the potential Opposer, but the settlement terms offered were more egregious than what the Opposer could obtain from the TTAB even if the Opposition was successful. Because my client was a small business, she could not afford the time necessary to fight this proceeding. Upon our suggestion, she expressly abandoned her application before the potential Opposer actually filed an Opposition. If the Opposition had been filed, my client would not have been able to withdraw her application without the consent of the Opposer and the terms that the Opposer were so onerous that to comply my client would have had to cease operating her business. If I provided you with the owner of the potentially opposing company, you could search the TTAB records to see the myriad of oppositions or extensions filed by the company against many applicants. To my knowledge, although some companies filed answers to oppositions and affirmative defenses asking that the Opposer's mark be canceled for fraud on the TTAB, no company ultimately took the matter to trial.

Prof. Barbara B. Bressler, Director
Center for Intellectual Property Law and Information Technology (CIPLIT)
DePaul University College of Law
25 E. Jackson, Suite 806
Chicago, Illinois 60604
(b)(6)